REMARKS

Applicants appreciate the courtesies extended by Examiners Milton Cano and Robert Madsen during an interview on July 15, 2004 with Applicants' attorney, Jeffrey A. Wolfson. The comments appearing herein summarize, and are substantially in accord with, those presented and discussed during the interview.

Claims 26-28, 30, 32-36 and 38-46, as amended, are pending for the Examiner's review and consideration. Claims 26 and 38 have been amended to more accurately recite that the claimed invention is a food product that comprises a biscuit layer and a cream composition. While this amendment is made as requested by the Examiners, it is not believed to modify the scope of the claim or introduce new issues. Claims 26 and 38 have been amended to recite the language comprising certain preferred sugars. This does not introduce a new issue or modify the claim scope, because the Office Action has expressly ignored the "consisting essentially of" language previously recited in these claims with respect to the types of sugar (Office Action mailed April 26, 2004 at page 6, lines 4-7). Moreover, claims 26 and 38 have been amended to recite preferred aromatic compounds including honey, cocoa, coffee, caramel, hazelnuts, almonds, vanilla, fruit chunks, fruit syrup, whole fruits, concentrated fruit juices, or a combination thereof as suggested by the Examiner at the interview (*See, e.g.*, Specification at page 3, lines 6-10). Dependent claim 29 has been canceled and its features added to independent claims 26 and 38, which now further recite that the food product includes 10% to 45% of a molten fatty substance (*See, e.g.*, Specification at page 6, lines 22-31). No new matter or new issues are believed to have been added by way of these amendments, such that their entry at this time is warranted.

Claims 26, 28, 30, 32-33, 35 and 46 were rejected under 35 U.S.C. § 103(a) as being obvious over EP0773722 B1 to Hilhorst et al. ("Hilhorst") in view of U.S. Patent No. 5,624,702 to Schotel ("Schotel") and the publication "Nutritive Value of Foods" by Gebhardt et al. ("Gebhardt") on page 2 of the Office Action, as well as for being obvious over Schotel in view of Gebhardt on page 3 of the Office Action. Hilhorst is alleged to teach a composition comprising 12% sugar, 10-40% fermented dairy, 3.3% and 5% maltodextrin, aromatics at less than 2%, and up to 4% salt that is spread on bread (*See* Office Action, pages 3-4). Hilhorst is also alleged to teach dairy cream (40% and 45% fat) in an amount such that the total of fermented dairy and dairy cream is up to 40% of the spread. (*Id* at page 4).

Initially, claims 26 and 38 recite the feature previously recited in claim 29, *i.e.*, that the food product includes 10% to 45% of a molten fatty substance. The Examiner's position is that any fat in a reference can be "extracted" from the various components and

used to arrive at a total amount of fat in the composition or product. For example, a food product made of 50% butter with 5% fat and 50% chocolate with 5% fat contains 10% fat. In view of this Patent Office position, the present claims are clearly patentably distinct from former claim 29, which feature is now present in independent claims 26 and 38.

The two primary references used separately or in combination in all rejections are Hilhorst and Schotel, each of which is directed to a *low-fat spread*. Hilhorst specifically states that "low fat products can be obtained" and that its invention provides an "edible spread having a solid fat content at 10°C below 10% by weight" (Hilhorst at page 2, lines 43-51). Indeed, every single example of Hilhorst according to its invention contains less than 10% fat. Only Example VIII, which is apparently not according to Hilhorst's invention, teaches more fat content. Because Example VIII is not according to Hilhorst, and because Example VIII is insufficient for the Patent Office to impose an anticipatory rejection based on its limited teachings, Hilhorst as a whole expressly *teaches away* from using spreads with high levels of fat.

Schotel, entitled "Low-Fat Spread," similarly teaches a low-fat spread that is predominantly water (Col. 4, lines 37-41) and can include up to 7 wt% of fat (Col. 3, lines 1-4). Thus, Schotel teaches even less fat content than Hilhorst.

On the contrary, the present invention now recites a fat content of 10% to 45% molten fatty substance. In addition, considering the fat content of other components of the present invention, the claimed food products also include--at a minimum--the fat present in: (a) the 10% to 20% of a milk derivative; (b) the fat present in the 10% to 60% of a fermented dairy product; and (c) the fat present in the about 5% to about 25% of sour cream or dairy cream containing 25% to 45% of fatty substances, *i.e.*, 1.25% to 11.25% fat. Thus, adding the 1.25% to 11.25% fat to the 10% to 45%, the claimed food products contain--at a minimum--11.25% to 56.25% fat, and even more when considering the fat in the presently claimed milk derivative and the fermented dairy product. Hilhorst and Schotel each individually, and together, fail to disclose or even suggest such high fat content as presently recited. Further, one of ordinary skill in the art would not have been motivated to experiment with a higher fat level in a spread than those taught by the cited art because this would have been contrary to the teachings of Hilhorst and Schotel. Because both Hilhorst and Schotel disclose low-fat spreads with less than 10% fat, they individually and in combination *teach directly away* from the claimed invention, which recites 10% to 45% molten fatty substance plus other fat present in other recited components.

Even if these fatal deficiencies were not sufficient to demonstrate on the record that no *prima facie* case of obviousness exists, there are several other claimed features that are also not taught by the prior art of record. The Office Action refers back to the previous Office Action, in which the Patent Office conceded that Hilhorst is silent in teaching a specific level of dairy cream and using a milk derivative, such as skim milk powder, and is silent in teaching a particular water activity of 0.75-0.91 as presently claimed. Hilhorst also fails to teach aromatic products in amounts of 0.01% to 20%, as presently recited. The amendment to include the types of aromatic products disclosed in the specification is not a new issue, but rather is included merely to more clearly and distinctly recite the claimed invention as requested by the Examiners. The position of the Patent Office was that "aromatic products" included coffee extract, such as Example VIII (which is different from, and contradictory to, Hilhorst's low fat invention). Even so, coffee is taught in Hilhorst's Example VIII to be present in an amount of 31.8 percent, which is significantly different from the presently claimed 0.01 to 20 weight percent aromatic product. For these additional reasons, the cited prior art of record fails to teach the claimed invention.

Furthermore, Hilhorst fails to teach the claimed 0.01% to 20% of an aromatic component. Hilhorst does generically teach a flavoring agent in amounts "less than 0.5 wt.%, for example 0.01 to 2 wt.%" (Hilhorst, page 4, lines 16-17). What is claimed, however, is an *aromatic product* (*See* claim 26). Claim 26 has been amended to expressly recite the various aromatic products present in the specification, as suggested by the Examiners. As such, this amendment is not believed to be a new issue for this reason and because it has been previously discussed. Moreover, as previously discussed, Hilhorst discloses an aromatic product--coffee-- in a single Example VIII, but the amount is far greater and substantially different than that presently claimed.

Additionally, nothing in Hilhorst suggests that its flavoring agents are the same or even similar to the aromatic products of the claimed invention, and as noted herein. Moreover, Examples VI, VII and VIII of Hilhorst support this difference from the claimed invention. Example VI discloses a sweet banana spread with 40% banana puree, and "no flavoring masking additives were needed." Example VII discloses a milk-based spread with 43.78% of milk, while Example VIII discloses a milk-based spread with 31.8% of a coffee extract. As can readily be seen, the flavoring materials of Hilhorst cannot be the banana puree, milk, or coffee extract of Hilhorst's examples, since all of these components are present in amounts much greater than the 2% disclosed in Hilhorst. These components taught by Hilhorst are similar, if at all, to the aromatic products in the claims. Even if they are

similar, however, the proportions of the aromatic products claimed is 0.01% to 20%, while that disclosed by Hilhorst is from 31.8% to 43.78%, which is clearly outside the claimed range. This is yet another illustration of the substantial differences of Hilhorst's low-fat product compared to the claimed invention.

More importantly, none of the cited references disclose or suggest a cream composition that has a water activity of 0.75 to 0.91, as presently recited in independent claim 26. As the Examiner simply refers to a previous Office Action regarding this important point, it is clear that the Patent Office has not provided any evidence of record to support the unsupported, conclusionary statement that "since Hilhorst teach[es] a water continuous spread with the recited composition one would expect a similar water activity of 0.75-0.91" (Office Action, page 5). The Office Action on page 7 states that the same process is used by the references and the references include the broadly claimed compositions. On the contrary, due to a Restriction Requirement the Examiner has clearly not examined the methods of making the claimed food product, which differ from those of the cited art, *e.g.*, by adjusting the temperature upwards to 15°C to 40°C after pasteurizing and cooling, and by including a molten fatty material. Moreover, as discussed herein, it is extremely clear that the references of record--even in combination--completely fail to disclose and do not suggest numerous recited features of claims 26 or 38. Further, as seen by the various disparate prior art references cited by the Examiner throughout the lengthy prosecution of this application, there are a great variety of spreads and dairy materials having a wide range of water activities. Importantly, water activity is relatively unpredictable and can depend--as noted by the Examiner at the interview--on processing differences, as well as depending on product differences. Both differences are present when comparing the claimed invention with the cited art. Therefore, it is improper hindsight rejection, and there is nothing in the cited art of record, to remotely suggest that Hilhorst or Schotel will provide the claimed water activities, particularly in view of the differences of these references from the claimed invention.

Both Schotel and Gebhardt, individually or combined, do not remedy these serious deficiencies of Hilhorst. Schotel, as discussed above, does not teach the above-mentioned features including any specific water activity or even a general teaching regarding the same, while Gebhardt is merely a listing of the nutritive values of the edible parts of foods and particularly for protein levels. The claims do not recite protein content and therefore, Gebhardt is completely irrelevant to the claimed invention. Both references fail to disclose or even suggest the features that are lacking in Hilhorst.

At a minimum, Hilhorst, Schotel, and Gebhardt fail to teach the molten fatty substance, teach away from the fat content of the recited invention, fail to teach the claimed 0.01 to 20% of an aromatic product, and fail to teach the claimed water activity. Because the cited references, either individually or combined, do not disclose or suggest all of the features of the present invention, independent claim 26, as well as dependent claims 28, 30, 32-33, 35 and 46 cannot be obvious over Hilhorst in view of Schotel and/or Gebhardt. Applicants disagree with the characterizations by the Office Action as to various dependent claims, however, such discussion is moot in view of the patentability of independent claim 26. Thus, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn, since no *prima facie* case of obviousness has been stated.

Claims 38 and 42 were rejected under 35 U.S.C. § 103(a) as obvious over Schotel evidenced by Gebhardt (*See* Office Action, pages 4-5). Applicants respectfully traverse this rejection for the same reasons given with respect to claims 26, 28-30, 32-33, 35 and 46.

Independent claim 38 recites the transition language "consisting essentially of," which has a well defined legal interpretation. The term "consisting essentially of" is intermediate in scope compared to "comprising" and "consisting of." This term is open to cover additional components but excludes components or ingredients that would "'materially affect the basic and novel characteristics' of the claimed composition." *Atlas Powder Co. v. E.I. Du Pont de Nemours*, 750 F.2d 1569, 1574 (Fed. Cir. 1984) (quoting *In re Herz*, 537 F.2d 549, 551 (C.C.P.A. 1976)). Thus, for a claim that recites "a product consisting essentially of components A and B," literal infringement by a product that contains A, B, and C would be found when component C does not materially change (*i.e.*, have a material effect on) the properties of a product that contains only A and B.

The Office Action has ignored the limitation "consisting essentially of" in the preamble of the cream composition of claim 38, which is improper. The transition language was explicitly added to exclude other sugar components besides those recited in the claim. It is not intended to exclude any other components. The basis for this exclusion, as required by MPEP § 2111.03, exists in Hilhorst itself. The present invention advantageously provides organoleptically pleasing compositions using the recited sugars. It is well known in the art, however, that a well known problem with oligofructoses is that their use in spreads results in an "undesired sweet off-taste" (*See, e.g.*, Hilhorst, page 2, lines 21-22). Thus, the use of the transition "consisting essentially of" in claim 38 excludes the use of oligofructose materials,

which would be expected to create an undesired off-taste if included in the food product of the present invention. Indeed, because oligofructoses are undesirable in the food products of the claimed invention, those of ordinary skill in the art would not have been motivated to rely on Schotel, or Hilhorst for that matter, as a basis for arriving at the claimed invention because each teaches to include a significant portion of oligofructose. In fact, Schotel (and Hilhorst) *teach away* from the invention recited in claims 38 and those dependent therefrom, which exclude oligofructoses by virtue of the "consisting essentially of" transition language in claim 38.

Indeed, Product D of Schotel, which contains only the oligofructose, had an inferior taste and appearance when compared to Examples A-C (Col. 5, lines 22-24). Therefore, one of ordinary skill in the art would have expected that both types of sugars disclosed by Schotel, *i.e.*, an oligofructose and a mono or disaccharide, were required to obtain a suitable material. This effectively *teaches away* from the present invention, which excludes oligofructoses by virtue of the transition language "consists essentially of.". As previously noted, oligofructoses are likely to have an adverse impact on the flavor and/or texture of the claimed invention. Indeed, this undesirable trait is demonstrated by Schotel in its examples.

Amazingly, the Office Action improperly states that "Applicant believes that oligofructose would impart an adverse texture and or tasted." This is not a matter of Applicants' belief--rather, the cited art of record expressly states that a problem with oligofructoses is that their use in spreads results in an "undesired sweet off-taste" (*See, e.g.*, Hilhorst, page 2, lines 21-22). The Office Action further explains that Schotel still manages to provide a suitable product, but this completely and erroneously ignores the teachings of Schotel as a whole. To obtain suitable products in spite of the oligofructose, Schotel must include various other components and amounts of components that would be expected to modify the food product presently recited. There is no teaching in the cited art of record to suggest which components should be included or excluded when modifying Schotel to obtain a good flavor with oligofructoses and still arrive at the claimed invention. Simply put, it is the essence of hindsight rejection to select certain desired components of Schotel based on the present application when it is clear from the cited references of record that this would drastically and undesirably affect the flavor or other characteristics due to the oligofructose present in the cited art.

Bald assertion is not sufficient to maintain this rejection, as the Federal Circuit requires that a teaching be present in the cited art of record. In the obviousness context, a

motivation must have existed for one of ordinary skill in the art to combine the references--and this lack of such a motivation in the art of record demonstrates the patentability of the claims over the cited references, or at the very least demonstrates the lack of a *prima facie* case of obviousness by the Patent Office. *In re Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir., 2002) (finding that the Board of Patent Appeals and Interferences improperly relied upon common knowledge and common sense of person of ordinary skill in art to find invention of patent application obvious over combination of two prior art references, since factual question of motivation to select and combine references could not be resolved on subjective belief and unknown authority). Absent the motivation to avoid oligofructoses, Hilhorst and/or Schotel provided no motivation to exclude these off-taste sweeteners or to include them but only along with certain taste masking agents that otherwise affect various characteristics of the claimed food product.

Moreover, the water activity in claim 38 is 0.86 to 0.91, and claim 38 recites that the cream composition must be maintained under refrigeration. The Examples in the specification clearly support the surprising and unexpected benefits achieved in food products of the invention of claim 38. As such, a combination of Schotel and Gebhardt still fails to teach or disclose all of the features of the invention recited in claim 38, as previously discussed. For these reasons, Applicants respectfully request that this rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn since no *prima facie* case of obviousness has been demonstrated on the record.

Various dependent claims were rejected over numerous other combinations of references. Applicants do not address these rejections separately herein, as they are moot for at least the reason that they depend from independent claims 26 and 38.

Accordingly, Applicants now believe all claims are in condition for allowance. Should the Examiner not agree with this position, a telephone or personal interview is requested to resolve any remaining issues and expedite allowance of this application.

Respectfully submitted,

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Date

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